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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,087	11/09/2001	Mark C. Sapienza	010371-9025-00	2568

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MICHAEL BEST & FRIEDRICH, LLP
100 E WISCONSIN AVENUE
MILWAUKEE, WI 53202

EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,087

Applicant(s)

SAPIENZA ET AL. 

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-8 and 10-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,511,246 in view of Dattel (6,220,775). The patented claims set forth the claimed invention except for explicitly disclosing a sheet holder having first and second covers wherein the second cover includes a substantially elliptical cutout completely within a perimeter of the second cover, the second cover including a recessed edge having a projection and the first cover having a width greater than the width of the second cover.

Dattel discloses a folder for filing documents comprising lateral faces (2, 3) wherein the face (2) includes a substantially elliptical cutout (19) completely within a perimeter of the face and the same face including a recessed edge having a projection (see annotation of figure 1). Dattel further discloses modifying the widths of the faces

(see col. 2, lines 61-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the patented claims to include a sheet holder, as taught by Dottel, for providing an alternative design for retaining sheets of paper.

3. Claims 9 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,511,246 in view of Dottel and further in view of Fournier (4,970,905). The patented claims, as modified by Dottel, disclose the claimed invention except for the sheet holder being a spiral-bound notebook.

Fournier discloses a coil-bound notebook. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the patented claims to provide the sheet holder being a spiral-bound notebook, as taught by Fournier, as an alternative device for holding the stack of sheets.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leitman (4,516,871).

Leitman discloses a looseleaf binder (12) comprising a first cover (14); a tab coupled (by way of the bar 20) with the first cover and with one or more sheets in a stack, the tab extending beyond the one or more sheets (as seen in figure 1); and a second cover (16) coupled with the first cover.

Regarding the second cover being configured to permit viewing of the tab when the first and second covers are in a closed position, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the first and second covers of any material (i.e., transparent) enabling viewing of the contents therein, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 18, it would have been an obvious matter of design choice to provide any desired dimensions for the covers, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 19, the sheet holder is a ring binder.

6. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leitman in view of Dattel.

Leitman disclose the claimed invention except for explicitly disclosing a sheet holder having first and second covers wherein the second cover includes a substantially

elliptical cutout completely within a perimeter of the second cover, the second cover including a recessed edge having a projection and the first cover having a width greater than the width of the second cover.

Dottel discloses a folder for filing documents comprising lateral faces (2, 3) wherein the face (2) includes a substantially elliptical cutout (19) completely within a perimeter of the face and the same face including a recessed edge having a projection (see annotation of figure 1). Dottel further discloses modifying the widths of the faces (see col. 2, lines 61-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Leitman to include a sheet holder, as taught by Dottel, for providing an alternative design for retaining sheets of paper.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leitman in view of Fournier.

Leitman discloses the claimed invention except for the sheet holder being a spiral-bound notebook.

Fournier discloses a coil-bound notebook. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Leitman to provide the sheet holder being a spiral-bound notebook, as taught by Fournier, as an alternative device for holding the stack of sheets.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose indexing systems.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


MONICA CARTER
PATENT EXAMINER

February 6, 2003